

CUSTOMER NO.: 24498
Serial No.: 10/761,512
Office Action dated: November 16, 2006

PATENT
PF030028

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REMARKS

The Office Action mailed November 16, 2006 has been reviewed and carefully considered. No new matter has been added.

Claims 1, 2, 4, 5, 6, and 11 have been amended. Claim 14 has been cancelled, without prejudice. New Claims 15 and 16 have been added. Claims 1-13 and 15-16 are pending.

Claims 1, 2, 4-6, 11, and 14 have been objected to because of informalities.

Claim 1 has been amended to now recite "wherein said slave digital terminal" in place of "characterized in that said slave digital terminal". As wherein clauses are customarily indented, it is believed that the amended version of Claim 1 is proper and without confusion.

Claim 2 has been amended to replace "the" with "a", before "data broadcasting system", thus providing proper antecedent basis.

Claim 4 has been amended to now recite, *inter alia*, "System according to Claim 3".

Moreover, Claims 4 and 6 have been amended to now recite "descrambling" in place of "descrambling and/or deciphering" and "descrambling/deciphering".

Claim 5 has been amended in accordance with the Examiner's suggestions.

Claim 11 has been amended in accordance with the Examiner's suggestions.

As noted above, Claim 14 has been cancelled.

All issues objected to by the Examiner have been addressed. Withdrawal of the objections is respectfully requested.

Claims 1, 8, 9, and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0098583A1 to Weber (hereinafter "Weber"). Moreover, Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,904,522 to Benardeau et al. (hereinafter "Benardeau"). Further, Claims 2-7 and 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weber in view of Benardeau.

As noted above, Claim 14 has been cancelled.

It is respectfully asserted that none of the cited references teach or suggest "wherein said slave digital terminal can access said protected data only if information necessary for accessing said data and received by the master digital terminal is sent by way of said link to the slave digital terminal within a predetermined deadline", as recited in independent Claim 1.

Further, it is respectfully asserted that none of the cited references teach or suggest "wherein the digital terminal can access said protected data only if information necessary for accessing said data and received by another digital terminal to which it can be connected, is sent to it by this other terminal within a predetermined deadline", as recited in independent Claim 13.

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In contrast to the preceding limitations of Claims 1 and 13, Weber discloses that a sending device measure the time between a request for acknowledgement and a receipt of the acknowledgement (Weber, FIG. 1).

However, the time between a request for an acknowledgement and the receipt of the same does not correspond to a predetermined deadline by which information necessary for accessing protected data is received by a particular terminal, as per Claims 1 and 13. For one thing, neither a request for an acknowledgement or the resulting acknowledgement correspond to information necessary for accessing protected data. The request for an acknowledgement or the resulting acknowledgement would have to instead be or to instead include, for example, a secret key.

For example, as disclosed in the Applicants' specification relating to a first embodiment, at page 6, lines 27-33:

[T]he message << EMM (Slave Entitlements) >> is sent during step 204 while being protected by enciphering. For example, it is assumed that the modules for managing the pairing 17 and 27 that are present in the terminals 1 and 2 each posses a secret key shared by the two modules 17 and 27. The module 17 enciphers the message << EMM (Slave Entitlements) >> with the secret key before dispatching it over the link 3 and the module 27 decipheres it with the secret key when it receives it.

Accordingly, the sending of a request for acknowledgement and the receipt of the acknowledgement, without more, does not disclose or even remotely suggest the preceding limitations of Claims 1 and 13. That is, using the terminology of Weber, a "communication channel round-trip response time" (Weber, paragraph [0007]) does not correspond to a digital terminal being able to access protected data only when the digital terminal receives from another digital terminal, within a predetermined deadline, information necessary for accessing the protected data, as set forth in Claims 1 and 13.

It is to be noted that the citation of paragraph [0003] of Weber for the purpose of showing shared secrets and key exchange are so described in Weber with respect to the prior art, in the background section of Weber's patent and not as part of his invention. In fact, Weber

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teaches away from the use of secret keys for example, at least at paragraph [0005] thereof, where Weber discloses (sic):

A problem arises when the authentication method used by the sending device to authenticate the receiving device, is comprised. If an authorized receiving device acquires the shared secret or the exchange key, the unauthorized receiving device may use the shared secret or the exchanged key to 13208.126 convince the sending device that the unauthorized receiving device is authorized to receive the digital content.

Thus, to explicitly avoid this problem, Weber takes a different approach than that of using secret keys, by "using communication channel round-trip response time for digital asset management", where "a predetermined distance between the sending device and the receiving device" is used "to prevent unauthorized receipt of the digital content when the unauthorized receiving device is located beyond the predetermined distance from the sending device."

Moreover, while Claims 1 and 13 recite, *inter alia*, that "... said slave digital terminal can access said protected data only if information necessary for accessing said data and received by the master digital terminal is sent by way of said link to the slave digital terminal within a predetermined deadline" Weber discloses that the digital content is NOT SENT when "the actual round-trip response time is not within the predetermined response time limit" (Weber, para. [007]). Thus, while the inventions of Claims 1 and 13 do not preclude receiving the data and such receipt is actually inherent for that data to be accessible in the first place, here another difference lies between Claims 1 and 13 and Weber regarding the accessing of the data (already inherently received, see FIG. 1 and page 4, lines 29-32 of the Applicants' specification) versus the sending of the data in the first place.

Moreover, given the statements by Weber of using secret keys and his disclosed methodology of avoiding the same, the following text of MPEP §2143.01 is provided to the Examiner:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

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(Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Here, the use of secret keys in Weber would change the principle of operation (of avoiding the use of secret keys and the like) of the prior art invention being modified (Weber), thus rendering the teachings of Weber insufficient to render the claims *prima facie* obvious. Accordingly, Weber is not properly useable in the rejection proposed by the Examiner, and its withdrawal from the same is respectfully requested.

Thus, as noted above, Weber does not teach or suggest all of the limitations of Claims 1 and 13 and, in fact, teaches away from the same. Moreover, as noted above, the use of Weber is improper, as it the proposed modification of Weber by the Examiner would change the principle of operation of the prior art invention being modified (Weber), thus rendering the teachings of Weber insufficient to render the claims *prima facie* obvious under MPEP §2143.01.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Accordingly, Claims 1 and 13 are patentably distinct and non-obvious over Taniguchi for at least the reasons set forth above.

Claims 8 and 9 depend from Claim 1 and thus include all the elements of Claim 1. Accordingly, Claims 8-9 are patentably distinct and non-obvious over the cited reference for at least the reasons set forth above with respect to Claim 1.

Further, Benardeau is silent with respect to the above-recited amended limitations and also does not teach or suggest such limitations now recited in Claims 1 and 13.

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"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

Accordingly, it is respectfully asserted that none of the cited references, either taken singly or in any combination, disclose all of the limitations recited in independent Claims 1 and 13. Thus, Claims 1 and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Further, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claims 2-7 and 10-11 depend from Claim 1 or a claim which itself is dependent from Claim 1 and, thus, includes all the elements of Claim 1. Accordingly, Claims 2-7 and 10-11 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 1.

Thus, reconsideration of the rejections is respectfully requested.

Further, Claims 1-14 have been provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-14 of co-pending U.S. Patent Application No. 10/766,092.

It is respectfully asserted that U.S. Patent Application No. 10/766,092 has been abandoned. While an outstanding Office Action is known to be pending against U.S. Patent Application No. 10/766,092, again the intent is to abandon it, so no response will be filed in that case, and only this case (U.S. Patent Application No. 10/761,512) is going to be further prosecuted. Accordingly, the provisional rejection under 35 U.S.C. §101 should be considered moot and, thus, reconsideration of the rejection is respectfully requested.

Moreover, as noted above, new Claims 15 and 16 have been added. Claims 15 and 16 recite, *inter alia*, "wherein the information necessary for accessing said protected data comprises a secret key". It is respectfully asserted that since independent Claims 1 and 13 were rejected under 35 U.S.C. §102(e) as being anticipated by Weber, and Weber is not proper in a rejection of the pending claims for at least the reasons set forth above including, for example, that Weber does not teach all of the limitations of Claims 1 and 13, that Weber teaches away from the subject matter of Claims 1 and 13, and that modification of Weber as per the Examiner's proposed combination would change the principle of operation (avoiding the use of keys) of Weber, thus rendering the teachings of Weber insufficient to render the claims *prima facie* obvious under MPEP §2143.01, Claims 15 and 16 are patentably distinct

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and non-obvious for at least the same reasons as Claims 1 and 13. That is, since Claims 15 and 16 respectively depend from Claims 1 and 13 and, thus, respectively include all the limitations of Claims 1 and 13, Claims 15 and 16 are patentably distinct and non-obvious over Weber (and also Benardeau) for at least the reasons set forth above with respect to Claims 1 and 13, respectively. Moreover, the recitation of a secret key in Claims 15 and 16 further distinguishes said Claims from Weber and the proposed combination of Weber and Benardeau for at least the reasons set forth above.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of November 16, 2006 be withdrawn, that pending claims 1-16 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

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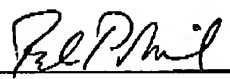
No fee is believed due with regard to the filing of this amendment. However, if a fee is due, please charge Deposit Account No. 07-0832.

Respectfully submitted,

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